

Remarks

The present amendment is made in response to the first Official Action, dated December 24, 2002, and identified as Paper No. 8. In the Action, the Examiner has rejected claims 1-6 and 8-14 under 35 U.S.C. §112, Paragraph 2, and rejected claims 1-14 under 35 U.S.C. §103(a) as unpatentable over Petteruti et al (U.S. Patent 5,503,483). The §112 rejections are believed to have been overcome by the present amendment, and Applicant respectfully traverses the Examiner's rejection to the claims under §103.

Relative to the §112 rejection, independent claims 1 and 8 have each been amended to delete the phrase "such as a circle about an item or a watermark." Claims 1-6 and 8-14 are now believed to be definite for purposes of satisfying 35 U.S.C. §112, Paragraph 2, and the Examiner's reconsideration is respectfully requested.

Relative to the §103(a) rejection, it is Applicant's position that the Examiner has not made a prima facie case of obviousness. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of

success must be both found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). See MPEP §2143 - 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the application claims, and the references must expressly or impliedly suggest the claimed invention or the Examiner must provide a convincing line of reasoning as to why the artisan would have found the claim invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The *Petteruti* patent relied upon by the Examiner in making the §103 rejection falls short of making a prima facie case of obviousness on all three grounds stated above. First, *Petteruti* provides no teaching or suggestion for "merging said graphic with text in real time" (claims 1 and 8), or "using a font cell from said font information, and selectively adding a dot row to an intermediate portion thereof; selecting a dot row axis; repeating steps (a) - (c) to generate a strike-through" (claim 7). *Petteruti* broadly discloses a printer having the capability to print a graphic, but the details as to how (or controlling where and when) a graphic is to be printed is not provided (most likely due to the fact that *Petteruti* is not directed to the manner in which graphics are to be printed, but rather to the structure of the printer itself). Because of the failure of *Petteruti* to provide these types of details all three prongs of

the obviousness prima facie case fail.

Submitted herewith is a Petition For Extension of Time under 37 CFR 1.136(a) for a three month extension, and an authorization to charge Deposit Account No. 50-1546 for any fee that may be required for this Petition.

In view of the present amendments as supported by the foregoing remarks, the Examiner's reconsideration and allowance of the instant application are respectfully requested. Should the Examiner feel that prosecution might be expedited by an interview, he is urged to contact the undersigned at (315) 218-8000.

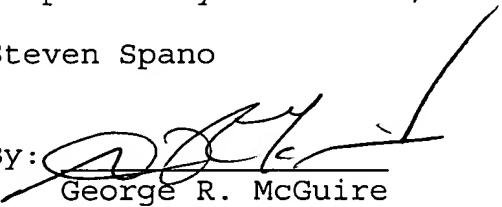
Respectfully submitted,

Steven Spano

Date:

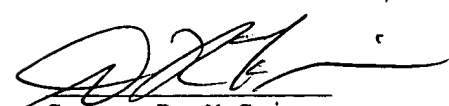
6/24/03

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I hereby certify that this correspondence is being deposited with the United States Postal Service on this date, in an envelope with sufficient postage as "first class mail," as cited under 37 CFR 1.8, addressed to: Mail Stop Non-Fee Amendment to the Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450 on June 24, 2003


George R. McGuire

Date: June 24, 2003

1. (Once Amended) A method of printing at least a portion of a sales receipt with a graphic, ~~such as a circle about an item or a watermark,~~ the steps comprising:

a) placing graphical information in memory;

b) forming a graphic using said graphical information;

c) merging said graphic with text in real time;

and

d) printing said graphic upon a sales receipt.

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8. (Once Amended) A method of enhancing at least a portion of a sales receipt with a graphic, ~~such as a circle about an item or a watermark,~~ the steps comprising:

a) placing graphical information in memory;

b) forming a graphic using said graphical information;

c) merging said graphic with text in real time;

and

d) printing said graphic upon a sales receipt.